

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1 and 47 are currently being amended.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate status identifier.

After amending the claims as set forth above, claims 1, 2, 4-25, and 27-69 are now pending in this application.

1. Rejection of Claims 24-46 Under 35 U.S.C. § 112 ¶ 1 as Failing to Comply With the Written Description Requirement

In section 3 of the Office Action, claims 24-46 were rejected under 35 U.S.C. § 112 ¶ 1 as failing to comply with the written description requirement.

The Office Action states:

[t]he claim(s) contain subject matter ‘the expansion slot and the slot in the housing both being configured to receive SD cards’ which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention. . . . ‘SDIO module based on the SD memory card’ does not necessarily mean that the slot is also configured to accept SD cards.

Office Action § 3.

Applicants point out that paragraph [0018] of Applicants’ specification states that “[i]n operation, a user of handheld computer 100 couples accessory device 130 to slot 140 . . . by sliding the SDIO card connector into slot 140 where an electrical connection is made between a connector on the SDIO card and an SD connector of handheld computer 100.” (emphasis added). Applicants respectfully submit that this disclosure reasonably conveys to

one skilled in the art that the slot, having an SD connector, is configured to accept and electronically coupled with SD cards.

Accordingly, Applicants respectfully submit that claims 24-26 comply with the written description requirement of 35 U.S.C. § 112 ¶ 1, and Applicants respectfully request that the rejection of claims 24-46 be withdrawn.

2. Rejection of Claims 1-2, 6-9, 11, 12, 14, 15, 18-20, 24-26, 29-32, 34, 35, 37, 38, 41-43, 47-49, 52-55, 57, 58, 60, 63-65, and 69 Under 35 U.S.C. § 103(a) as Being Unpatentable Over Mills et al. in View of SDA

In section 4 of the Office Action, claims 1-3, 6-9, 11, 12, 14, 15, 18-20, 24-26, 29-32, 34, 35, 37, 38, 41-43, 47-49, 52-55, 57, 58, 60, 63-65, and 69 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mills et al. (U.S. Patent No. 6,353,870) in view of SDA.

Claim 1 has been amended to recite “a slot in a housing of the handheld computer, the slot being a part of the interior of the handheld computer,” and “an expansion slot . . . entirely external to the interior of the handheld computer.” Applicants have amended claim 1 to clarify the structural features of the claimed subject matter. Applicants submit that Mills et al., alone or in any proper combination with SDA, fails to teach or suggest an expansion slot entirely external to the interior of the handheld computer. In response to the Examiner’s request that “Applicant is respectfully requested to point out the difference [from Mills et al.] in Applicant’s drawings,” Applicants point out that FIG. 5 of Applicants’ drawings clearly indicates that the expansion slot is entirely external to the interior of the handheld computer (including the slot in the housing). In contrast, FIG. 8 of Mills et al., referenced by the Examiner in the Office Action, shows a removable memory (120) that fits into a removable expansion card (100) that in turn fits in a slot in the PDA (200), where the slot for the removable memory is contained within the slot in the housing of the PDA and the interior of the PDA. Applicants therefore submit that Mills et al., alone or in any proper combination with SDA, fails to teach or suggest at least one limitation of independent claim 1. Accordingly, Applicants respectfully request that the rejection of independent claim 1, and corresponding dependent claims 2, 3, 6-9, 11, 12, 14, 15, and 18-20, be withdrawn.

Independent claim 47 contains similar limitations to independent claim 1, and recites a combination including, among other elements, “a slot in the interior of the electronic device,” and “[an] expansion slot configured to be located entirely external to the interior of the electronic device.” Applicants submit that independent claim 47 is patentable over the combination of Mills et al. and SDA for at least the reasons that claim 1 is patentable over the cited references. Accordingly, Applicants respectfully request that the rejection of independent claim 47, and corresponding dependent claims 48, 49, 52-55, 57, 58, 60, 63-65, and 69, be withdrawn.

Independent claim 24 recites a combination including, among other elements, “the expansion slot and the slot in the housing both being sized to accept and electronically couple with SD cards,” which is not taught or suggested by Mills et al., alone or in any proper combination with SDA. The Examiner acknowledged that “Mills does not explicitly disclose . . . the expansion slot and the slot in the housing both being sized to accept and electronically couple with SD Cards.” However, the Examiner went on to state that “SDA teaches SDIO module with SDIO interface to be coupled to the handheld computer (pages 1-2, and especially paragraph 2) and the slot can accept and electronically couple with SDIO cards, SD cards, and Multimedia cards.” The Examiner concluded that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the slot and SDIO module/SDIO interface as taught by SDA in the system of Mills to provide a compact product wherein the SDIO module will make it easy to add input/output capability.”

Applicants respectfully disagree. Mills et al. teaches a “closed-case removable expansion card” that fits into a first-sized slot in a PDA and also has its own second-sized slot to accommodate an SD card. The first-sized slot encompasses and is therefore necessarily larger than the second-sized slot. The handheld computer of present claim 24 could not be embodied in the expansion card of Mills et al. because the handheld computer of present claim 24 requires that “the expansion slot and the slot in the housing both be[] sized to accept and electronically couple with SD cards,” as recited in claim 24. The subject matter of claim 24 requires a different structure than that taught or suggested by Mills et al. Claim 24 requires that the expansion slot be located outside the interior of the handheld computer, as shown in the exemplary embodiment in Applicants’ FIGS. 3-5. The use of slots in the SDIO

module and the handheld computer that both “accept and electronically couple with SD cards” is not taught or suggested by any proper combination of Mills et al. and SDA. To modify Mills et al. in view of SDA to arrive at the subject matter of claims 24 would require further modifications that are taught only by Applicants’ own disclosure, amounting to improper hindsight reasoning. Accordingly, Applicants submit that Mills et al., alone or in any proper combination with SDA, fails to teach or suggest at least one limitation of independent claim 24, and Applicants respectfully request that the rejection of independent claim 24, and corresponding dependent claims 25, 26, 29-32, 34, 35, 37, 38, and 41-43, be withdrawn.

3. Rejection of Claims 4, 5, 27, 28, 50, and 51 Under 35 U.S.C. § 103(a) as Being Unpatentable Over Mills et al. in View of SDA, and Further in View of Petty

In section 5 of the Office Action, claims 4, 5, 27, 28, 50, and 51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mills et al. in view of SDA and further in view of Petty (U.S. Patent No. 6,389,486). Dependent claims 4, 5, 27, 28, 50, and 51 variously depend from independent claims 1, 24, and 47, which are believed to be patentable over Mills et al. in view of SDA. Petty fails to make up for the deficiencies of Mills et al. and SDA with respect to independent claims 1, 24, and 47, from which claims 4, 5, 27, 28, 50, and 51 depend. Accordingly, Applicants respectfully request that the rejection of dependent claims 4, 5, 27, 28, 50, and 51 be withdrawn.

4. Rejection of Claims 10, 33, and 56 Under 35 U.S.C. § 103(a) as Being Unpatentable Over Mills et al. in View of SDA, and Further in View of Jones

In section 6 of the Office Action, claims 10, 33, and 56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mills et al. in view of SDA and further in view of Jones (U.S. Patent No. 6,145,046). Dependent claims 10, 33, and 56 variously depend from independent claims 1, 24, and 47, which are believed to be patentable over Mills et al. in view of SDA. Jones fails to make up for the deficiencies of Mills et al. and SDA with respect to independent claims 1, 24, and 47, from which claims 10, 33, and 56 depend. Accordingly, Applicants respectfully request that the rejection of dependent claims 10, 33, and 56 be withdrawn.

5. Rejection of Claims 13, 36, and 59 Under 35 U.S.C. § 103(a) as Being Unpatentable Over Mills et al. in View of SDA, and Further in View of Nakashima

In section 7 of the Office Action, claims 13, 36, and 59 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mills et al. in view of SDA and further in view of Nakashima (U.S. Patent No. 6,182,204). Dependent claims 13, 36, and 59 variously depend from independent claims 1, 24, and 47, which are believed to be patentable over Mills et al. in view of SDA. Nakashima fails to make up for the deficiencies of Mills et al. and SDA with respect to independent claims 1, 24, and 47, from which claims 13, 36, and 59 depend. Accordingly, Applicants respectfully request that the rejection of dependent claims 13, 36, and 59 be withdrawn.

6. Rejection of Claims 16, 39, and 61 Under 35 U.S.C. § 103(a) as Being Unpatentable Over Mills et al. in View of SDA, and Further in View of Onari et al.

In section 8 of the Office Action, claims 16, 39, and 61 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mills et al. in view of SDA and further in view of Onari et al. (U.S. Patent No. 6,132,391). Dependent claims 16, 39, and 61 variously depend from independent claims 1, 24, and 47, which are believed to be patentable over Mills et al. in view of SDA. Onari et al. fails to make up for the deficiencies of Mills et al. and SDA with respect to independent claims 1, 24, and 47, from which claims 16, 39, and 61 depend. Accordingly, Applicants respectfully request that the rejection of dependent claims 16, 39, and 61 be withdrawn.

7. Rejection of Claims 17, 40, and 62 Under 35 U.S.C. § 103(a) as Being Unpatentable Over Mills et al. in View of SDA, and Further in View of Rajchel

In section 9 of the Office Action, claims 17, 40, and 62 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mills et al. in view of SDA and further in view of Rajchel (U.S. Patent No. 6,272,575). Dependent claims 17, 40, and 62 variously depend from independent claims 1, 24, and 47, which are believed to be patentable over Mills et al. in view of SDA. Rajchel fails to make up for the deficiencies of Mills et al. and SDA with respect to independent claims 1, 24, and 47, from which claims 17, 40, and 62 depend. Accordingly, Applicants respectfully request that the rejection of dependent claims 17, 40, and 62 be withdrawn.

8. Rejection of Claims 21, 22, 44, 45, 66, and 67 Under 35 U.S.C. § 103(a) as Being Unpatentable Over Mills et al. in View of SDA and Further in View of Miller

In section 10 of the Office Action, claims 21, 22, 44, 45, 66, and 67 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mills et al. in view of SDA and further in view of Miller (U.S. Patent No. 6,199,168). Dependent claims 21, 22, 44, 45, 66, and 67 variously depend from independent claims 1, 24, and 47, which are believed to be patentable over Mills et al. in view of SDA. Miller fails to make up for the deficiencies of Mills et al. and SDA with respect to independent claims 1, 24, and 47, from which claims 21, 22, 44, 45, 66, and 67 depend. Accordingly, Applicants respectfully request that the rejection of dependent claims 21, 22, 44, 45, 66, and 67 be withdrawn.

9. Rejection of Claims 23, 46, and 68 Under 35 U.S.C. § 103(a) as Being Unpatentable Over Mills et al. in View of SDA, and Further in view of Harari et al.

In section 11 of the Office Action, claims 4, 5, 27, 28, 50, and 51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mills et al. in view of SDA and further in view of Harari et al. (U.S. Patent No. 6,266,724). Dependent claims 4, 5, 27, 28, 50, and 51 variously depend from independent claims 1, 24, and 47, which are believed to be patentable over Mills et al. in view of SDA. Harari et al. fails to make up for the deficiencies of Mills et al. and SDA with respect to independent claims 1, 24, and 47, from which claims 4, 5, 27, 28, 50, and 51 depend. Accordingly, Applicants respectfully request that the rejection of dependent claims 4, 5, 27, 28, 50, and 51 be withdrawn.

10. Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a

check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

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By 

FOLEY & LARDNER LLP
Customer Number: 26371
Telephone: (414) 319-7306
Facsimile: (414) 297-4900

Matthew J. Swietlik
Attorney for Applicants
Registration No. 58,428